

Remarks

Applicants have carefully reviewed the Office Action mailed on August 12, 2010. Applicants respectfully traverse (and do not concede) all objections, rejections, adverse statements, and adverse assertions made by the Examiner. Claims 9, 12, 16-17, 19, 21-23 and 40-42 are pending in the application and are rejected. With this amendment, claims 9 and 40 are amended. There is support for the claim amendments in the specification and drawings as originally filed. No new matter is added. Claims 9, 12, 16-17, 19, 21-23 and 40-42 are presented for examination.

Claim Rejections Under 35 U.S.C. §103

Claims 9, 12, 16-17, 19-23 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Griffin et al. in U.S. Patent Application Publication No. 2003/0125751 in view of Muni et al. in U.S. Patent No. 5,316,706 and further in view of Tassel et al. in U.S. Patent Application Publication No. 4,531,943.

Regarding claims 9, 12, 16-17, 19-23 and 38, independent claim 9 is amended to recite “wherein when the tip directly contacts the distal stop and the elongate tubular member is forced distally relative to the guidewire, the elastic portion of the tip inverts inwardly and the radially inextensible distal portion enters an internal cavity within the tip”.

In contrast, Griffin discloses a shank 9 including “a distal nose 202 of a relatively hard material at the distal end of the relatively soft polymeric member 31.” (paragraph 0266, repeated in paragraph 0303) The Office Action states that “it is the examiner’s position that the tip is perfectly capable of inverting proximally into the lumen if enough pressure is applied to the tip when it abuts an object such as the guidewire stop. The tip is capable of such a deformation if the right conditions are present, and therefore is capable of meeting this functional language.”

Applicants disagree with the Examiner’s characterization of the device of Griffin. Nowhere in Griffin is there any indication that any element inverts inwardly under any circumstances, or that the radially inextensible distal portion enters an internal cavity within the tip, as recited by claim 9. FIGs. 37-39 of Griffin appear to disclose that the distal end of the catheter is made of a flexible material, as noted by the Examiner in the

Office Action. In contrast to claim 9, FIGs. 37-39 of Griffin appear to teach that when the device is forced distally against the distal stop, the shank 9 deforms by compressing radially and translating proximally within distal shaft 4. There is no indication in Griffin that anything other than the radial compression and proximal translation will occur when the device is forced distally against the distal stop. Compare the radial compression and proximal translation, shown in FIGs. 37-39 of Griffin, with the geometry recited by claim 9, shown by example in FIGs. 3-4 of the present application.

As a result, Griffin does not teach or suggest “wherein when the tip directly contacts the distal stop and the elongate tubular member is forced distally relative to the guidewire, the elastic portion of the tip inverts inwardly and the radially inextensible distal portion enters an internal cavity within the tip”, as recited by amended independent claim 9.

In the Office Action, Muni is relied upon for teaching “that the crystallinity may be varied in any of a plurality of zones throughout the length thus indicating that many different portions can be soft or crystallized, depending on what is preferred.” As such, Muni does not remedy the deficiencies of Griffin in forming an obviousness rejection of amended independent claim 9.

Van Tassel discloses a soft tip member 24 with extreme tip 25. When the extreme tip is pushed against a stationary object, the tip assumes the shape shown in FIG. 5 of Van Tassel (column 4, lines 47-52). Specifically, the tip compresses longitudinally and expands radially, as shown in the figure. The tip of Van Tassel does not have an elastic portion that “inverts inwardly and the radially inextensible distal portion enters an internal cavity within the tip”. The extreme tip 25 of Van Tassel remains at the proximal edge of the top 24 at all stages of compression, and at no time “enters an internal cavity within the tip”, as recited by claim 9. As such, Van Tassel does not remedy the deficiencies of Griffin and Muni in forming an obviousness rejection of amended independent claim 9.

For the reasons set forth above, Applicants respectfully submit that amended independent claim 9 is patentable over Griffin. Muni and Van Tassel does not appear to overcome the shortcomings of the cited art. Consequently, Applicants respectfully submit that claim 9 is patentable over the combination of Griffin, Muni and Van Tassel,

to the extent that such a combination is even possible. Because claims 12, 16-17, 19-23 and 38 depend from claim 9, they are also patentable for the same reasons as claim 9 and because they add significant elements to distinguish them further from the art.

Claims 40-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over Griffin et al. in U.S. Patent Application Publication No. 2003/0125751 in view of Muni et al. in U.S. Patent No. 5,316,706 and further in view of Tassel et al. in U.S. Patent Application Publication No. 4,531,943.

Regarding claims 40-42, independent claim 40 is amended to recite “wherein when the tip directly contacts the distal stop and the elongate tubular member is forced distally relative to the guidewire, the elastic portion of the tip inverts inwardly and the radially inextensible distalmost extremity enters the enlarged cavity within the tip”.

For reasons similar to those presented for claim 9, Applicants assert that amended independent claim 40 is patentable over the combination of Griffin, Muni and Van Tassel, to the extent that such a combination is even possible. Because claims 41-42 depend from claim 40, they are also patentable for the same reasons as claim 40 and because they add significant elements to distinguish them further from the art.

Withdrawal of the obviousness rejections is respectfully requested.

Conclusion

Further examination and withdrawal of the rejections is respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

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Respectfully submitted,


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